

08/11/2003 10:51:13 AM

Docket No. 926536-922812

BOX TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

YOSHIDA METAL INDUSTRY CO., LTD.)
)
Opposer,)
)
v.)
)
GLOBAL DÉCOR,)
)
Applicant.)

Opposition No. 91/156,618
Appln. Serial No. 76/179,674
Mark: GLOBAL DÉCOR



Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

08-11-2003
U.S. Patent & TMO/TM Mail Rpt Dt. #22

Dear Commissioner:

APPLICANT'S ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM
IN RESPONSE TO YOSHIDA'S NOTICE OF OPPOSITION

Applicant, by and through its below signed attorneys hereby answers Opposer, Yoshida's opposition as set forth below. The answer is within the fifteen (15) day extension granted to Applicant by Opposer.

1. The Opposer, YOSHIDA METAL INDUSTRY CO., LTD., is a corporation duly organized and existing under the laws of Japan, having a corporate address of 1447-3, Shimonakano, Yoshida-machi Nishikanbara-gun, Niigata, JAPAN.

RESPONSE:

Applicant, Global Decor, Inc. lacks knowledge and information sufficient to form a belief as to the truth of the allegations of paragraph 1 and accordingly deny the same and demand strict proof thereof.

2. Commencing long prior to Applicant's claimed date of first use, Opposer has engaged, and is now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of a wide variety of knives, kitchen utensils and cooking utensils.

RESPONSE:

Applicant, Global Decor, Inc. lacks knowledge and information sufficient to form a belief as to the truth of the allegations of paragraph 2 and accordingly deny the same and demand strict proof thereof.

09/20/2008 11:14

3. Commencing long prior to Applicant's claimed date of first use, Opposer has used, and is now using Opposer's GLOBAL trademark (hereinafter sometimes referred to as "Opposer's Mark") in connection with a wide variety of knives, kitchen utensils and cooking utensils distributed and sold by Opposer in commerce.

RESPONSE:

Applicant, Global Decor, Inc. lacks knowledge and information sufficient to form a belief as to the truth of the allegations of paragraph 3 and accordingly deny the same and require strict proof thereof.

4. Opposer is the owner of, and will rely herein, upon the following Federal trademark registration.

<u>MARK</u>	<u>REGISTRATION NO.</u>	<u>ISSUED</u>
GLOBAL	2,419,827	January 9, 2001

Opposer's Registration No. 2,419,827 identifies the goods as "forks, utility knives, spoons, fish bone tweezers, whetstones, whetstone holders and knife steels", in International Class 8 and "turners, carving forks, spatulas, and knife blocks for holding knives", in International Class 21. Said registration of Opposer's Mark is valid and subsisting, and constitutes prima facie evidence of Opposer's right to use Opposer's Mark in commerce on the goods specified in said registration.

A copy of the Patent and Trademark Office TESS and TARR information for GLOBAL, U.S. Registration No. 2,419,827, is attached hereto, as Opposer's Exhibit 1.

RESPONSE:

Applicant, Global Decor, Inc. denies that Opposer's Exhibit 1 is a printout of information from the Trademark Office TESS and TARR database concerning Registration No. 2,419,827. Applicant lacks knowledge and information sufficient to form a belief as to the truth of the remaining allegations in paragraph 4 and accordingly denies the same and requires strict proof thereof.

5. In addition to the goods specified in the above-identified registrations, Opposer has also used Opposer's Mark for other and various related products, including but not limited to other kitchen utensils, cooking utensils and other items.

RESPONSE:

Applicant, Global Décor, Inc. lacks knowledge and information sufficient to form a belief as to the truth of the allegations in paragraph 5 and accordingly denies the same and requires strict proof thereof.

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6. Since its initial use of the aforementioned mark, Opposer has made a substantial investment in promoting its goods under its GLOBAL trademark. Opposer has extensively used, promoted and offered Opposer's goods bearing the mark to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's mark and associate same with Opposer and/or goods sold by Opposer. Opposer has built extensive good will in connection with the sales of products under its mark.

RESPONSE:

Applicant, Global Décor, Inc. denies the allegations set forth in paragraph 6.

7. Upon information and belief, notwithstanding Opposer's rights in and to its mark, on December 12, 2000, Applicant filed an application for registration of the alleged GLOBAL DECOR trademark for "chopsticks and chopstick dinner sets, forks, knives and spoons, hand held chopper, and non-electric can opener", in International Class 8 and "housewares in the nature of kitchen utensils, namely cookie cutters, baking pans, cheese cutters, serving spoons, serving ladles, pie servers, spatulas, draining spoons, skimming spoons, serving spoons, serving forks, wire egg cup holders, condiment bowls, pepper sauce holders, condiment steel shaker cans, stainless steel hand juicer, barware utensils, consisting of strainers, ice tongs, and condiment picks; seafood utensil sets consisting of shell cracker and seafood picks; bath and shower accessories, namely shower organizer, plunger, pop-up sink plugs, toothbrush holders, soap dish and towel hangars; toilet tissue rollers", in International Class 21. Said application was assigned Serial No. 76/179,674 and was published for Opposition in the *Official Gazette* of March 19, 2002, Vol. 1256, No. 3 at Page TM 118.

RESPONSE:

Applicant admits only that it filed an application to register the trademark "GLOBAL DECOR" on December 12, 2000 and received Serial No. 76/179,674. Applicant further admits that the application was published for opposition in the Official Gazette of March 19, 2002, Volume 1256, No. 3 at Page TM 118. Applicant denies the remaining allegations in paragraph 7.

8. Applicant's GLOBAL DECOR mark is a simulation and colorable imitation of, and so resembles Opposer's aforesaid GLOBAL trademark as to be likely, when applied to the aforesaid mentioned goods of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer, and its reputation.

RESPONSE:

Applicant denies the allegations set forth in paragraph 8.

9. Upon information and belief, Opposer and Applicant are both engaged in the sale and promotion of their respective goods through the same channels of trade, and to the same general class of purchasers.

06/11/2009 09:00:00 AM

RESPONSE:

Applicant denies the allegations set forth in paragraph 9.

10. Opposer, upon information and belief, avers that its customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's goods marketed under Applicant's alleged GLOBAL DECOR trademark set forth above and misled into believing that such goods are produced by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

RESPONSE:

Applicant denies the allegations in paragraph 10.

11. Opposer, upon information and belief, avers that it will be damaged by the continued use and registration by Applicant of the alleged GLOBAL DECOR trademark, as set forth in Applicant's Trademark Application Serial No. 76/179,674, in that the mark is substantially similar to Opposer's trademark and common law rights and is used in connection with goods similar to the goods offered to the public by Opposer.

RESPONSE:

Applicant denies the allegations set forth in paragraph 11.

12. This Opposer, YOSHIDA METAL INDUSTRY CO., LTD., believes and avers that it is being and will continue to be damaged by registration of the GLOBAL DECOR trademark as aforesaid, and prays that said Application Serial No. 76/179,674 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

RESPONSE:

Applicant denies that Opposer is being and will continue to be damaged by registration of the Global Decor trademark.

AFFIRMATIVE DEFENSES

Applicant, Global Decor, Inc. affirmatively states the following as its affirmative defenses to the Notice of Opposition.

Unclean Hands

13. The Opposition is barred by Opposer having unclean hands.

Laches Estoppel and Waiver

14. The Opposition is barred by the doctrine of Laches Estoppel and Waiver.

06/20/2003 11:14

Settlement Agreement

15. On or about July 2, 2002, Yoshida, through its attorneys, Birch, Stewart & Birch, LLP offered to resolve all matters set forth in Yoshida's Opposition provided Global Decor would make certain amendments to its description of goods in its application 76/179,674. A copy of the Offer of Settlement is attached as Exhibit A. On or around July 18, 2002, Global Decor, through its attorney, James Conte accepted the offer of settlement. Applicant was ready, willing and able to comply with the Settlement.

16. Global Decor has always and still remains ready, willing and able to perform all terms of the Settlement Agreement.

17. As a result of the Settlement Agreement, Yoshida has waived, released and/or discharged Global Decor from the above Opposition. Additionally, the offer and acceptance and Global Decor's reliance creates an estoppel preventing the Opposition.

Descriptiveness/Genericness

18. Yoshida's mark GLOBAL is merely descriptive, generic, laudatory and/or geographically descriptive of Yoshida's goods, thus as a matter of law, the concurrent use of Yoshida's mark with Applicant's mark cannot cause confusion.

COUNTERCLAIMS

Applicant, Global Decor, Inc. for its Counterclaims against Yoshida hereby alleges and avers in support of its Claim for Cancellation as follows:

Cancellation of Registration 2,419,827

1. Applicant, Global Decor, Inc. filed an application to register the mark "GLOBAL DECOR" on December 12, 2000, and received Application Serial No. 76/179,674.

2. Yoshida Metal Industry, Co., on or around May 28, 2003 filed a Notice of Opposition to the registration of Applicant's mark "GLOBAL DECOR", Application Serial No. 76/179,674.

09/20/2007

3. Opposer, Yoshida Metal Industry, Co., Ltd. to Support its Opposition Alleges that it Owns Registration No. 2,419,827 for the Mark "GLOBAL". Opposer relies on its alleged rights in Registration 2,419,827 to support its Opposition.

4. Yoshida Metal, in support of its opposition has alleged that registration by Applicant of the mark "GLOBAL DECOR" will damage Yoshida in that Applicant's mark is, according to Opposer, substantially similar to Opposer's trademark and is used in connection with goods similar to the goods offered to the public by Opposer and therefore, according to Opposer will likely cause confusion, mistake or deception as to the origin and sponsorship of Applicant's goods.

5. The registration for Global 2,419,827, Serial No. 75,599,789 is invalid and unenforceable for one or more of the following reasons:

a.) At the time the Statement of Use was filed to register the mark "GLOBAL", the owner of the mark had not made use of the mark as required under Section 1(a) and 1(d) of the Trademark Act.

b.) At the time the application to register the mark "GLOBAL" was filed, the term GLOBAL when used in connection with the goods specified in the application was merely descriptive of them in violation of 2(e) of the Trademark Act. The term Global is merely descriptive, generic, laudatory and/or geographically descriptive of the goods recited in the Global registration.

c.) The mark "GLOBAL" set forth in Registration 2,419,827 has not been sufficiently used by the owner in commerce to qualify as "use". The mark is now abandoned.

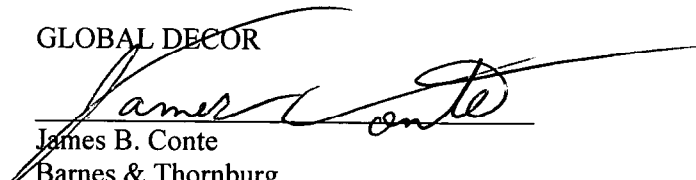
d.) At the time the Statement of Use was filed for the mark "GLOBAL", Serial No. 75599789, the owner of the mark knew that the mark was not used in commerce as required under Section 1(a) and 1(d) of the Trademark Act. Further, the owner of the mark knew that the date of first use of the mark in commerce specified in the application was not accurate. The false statements were made with the intent to deceive the Trademark Office and the public.

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6. As a result of one or more of the above acts, Registration 2,419,827 for Global is invalid and unenforceable. Maintenance of the registration will damage Applicant by helping to further Opposer's baseless opposition, and therefore the registration must be canceled in accordance with 15 U.S.C. §1064.

Respectfully submitted,

GLOBAL DECOR


James B. Conte
Barnes & Thornburg
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 357-1313

Date: August 7, 2003

08/20/2003 TTAB

PROOF OF SERVICE BY MAIL


Rose Ranegar, a non-attorney, certifies that on August 7, 2003, I served this **Applicant's Answer, Affirmative Defenses and Counterclaim in Response to Yoshida's Notice of Opposition**, by mailing a copy, postage prepaid, on the parties identified below:

Jeffrey H. Kaufman, Esq.
Amy C. Sullivan, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

BOX TTAB NO FEE
Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Under penalties as provided by the laws of the United States, I certify that the statements set forth herein are true and correct.

Date: August 7, 2003

Signature: 

6536-3000

BIRCH, STEWART, KOLASCH & BIRCH, LLP

TELL C. BIRCH
RAYMOND C. STEWART
JOSEPH A. KOLASCH
JAMES M. SLATTERY
MICHAEL K. MUTTER
CHARLES GORENSTEIN
GERALD M. MURPHY, JR.
LEONARD R. SVENSSON
ANDREW D. MEIKLE
MARC S. WEINER
JOE MCKINNEY MUNCY
ROBERT J. KENNEY
JOHN W. BAILEY
MARK U. NUEL, PH.D.
JAMES T. ELLER, JR.
D. RICHARD ANDERSON

INTELLECTUAL PROPERTY LAW
3110 GATEHOUSE ROAD
SUITE 500 EAST
FALLS CHURCH, VA 22042-1210
USA

(703) 205-8000

FAX: (703) 205-8050
(703) 698-8590 (G IV)

e-mail: mailroom@bskb.com
web: http://www.bskb.com

CALIFORNIA OFFICE
COSTA MESA, CALIFORNIA

SCOTT L. LOWE
PAUL C. LEWIS
RICHARD J. GALLAGHER
JAYNE M. SAYDAH*
MARYANNE ARMSTRONG, PH.D.
KECIA J. REYNOLDS
KALPANA REDDY
MARK E. OLDS
ESTHER H. CHONG
CATHERINE M. VOISINET*
EUGENE T. PEREZ
CAROLYN T. BAUMGARDNER*
JOHN L. CICOZZI*
JOHN P. KEADY, PH.D.
PING WANG, M.D.*
JACONDA WAGNER*
MARTIN R. GEISSLER*

OF COUNSEL:
HERBERT M. BIRCH (1905-1996)
BERNARD L. SWEENEY*
ELLIOT A. GOLDBERG*
WILLIAM L. GATES*
EDWARD H. VALANCE
RUPERT J. BRADY (RET.)*
F. PRINCE BUTLER
FRED S. WHISENHUNT (RET.)
JAMES W. HELLWEGE
QUENTIN R. "Rick" CORRIE
ROBERT F. GNUSE

*ADMITTED TO A BAR OTHER THAN VA.

REG. PATENT AGENTS:
FREDERICK R. HANDREN
MAKI HATSUMI
CRAIG A. McROBBIE
GARTH M. DAHLEN, PH.D.
ROBERT E. GOOZNER, PH.D.
KRISTI L. RUPERT, PH.D.
MATTHEW T. SHANLEY
SUSAN W. GORMAN, PH.D.
ROBERT W. DOWNS
CHAD J. BILLINGS
CHRISTINE A. VILLAPANDO
T. BENJAMIN SCHROEDER, PH.D.
PERCY L. SQUARE
CARL T. THOMSEN

CONFIRMATION

RECEIVED

Robert F.I. Conte, Esq.
LEE MANN SMITH MCWILLIAMS
& OHLSON
209 S. LaSalle Street
Suite 410
Chicago, IL 60604

July 2, 2002
Via facsimile
No. (312) 368-0034

Filed Away

Re: "GLOBAL DÉCOR" U.S. Trademark Appl'n No. 76/179,674
Your Reference: Unknown - Our Reference: 1131-0400T

Dear Mr. Conte:

We have discussed the above-identified matter with our client, and, in order to resolve this matter, we propose the following.

First, your client will delete the following goods in Classes 8 and 21 from its pending application(s) and refrain from attempting to register its mark in connection with those products in the future. The goods in issue are (1) "knives and hand-held choppers" in Class 08; and (2) "kitchen tools such as cheese cutters, serving spoons, serving forks and strainers" in Class 21.

In turn, your client can use the mark on all of the products currently listed in its application(s). This would include those to be specifically excluded above.

11/15/00 09:00 AM
Robert F.I. Conte, Esq.

July 2, 2002

Page 2

In addition, future issues of confusion between the marks would be addressed as necessary between the parties. This would include any confusion caused by your client's use of its mark in connection with those goods excluded from the application(s), as well as any other goods.

Please advise as soon as possible if this is acceptable.

We look forward to hearing from you shortly.

Very truly yours,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

Robert J. Kenney

RJK\

cc: Ms. Misao Toba

08/11/2003 09:00:21 AM

Docket No. 926536-922812

BOX TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

YOSHIDA METAL INDUSTRY CO., LTD.)
)
Opposer,)
)
v.)
)
GLOBAL DÉCOR,)
)
Applicant.)

Opposition No. 91/156,618
Appln. Serial No. 76/179,674
Mark: GLOBAL DÉCOR



Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

08-11-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Dear Commissioner:

UNOPPOSED MOTION FOR EXTENSION OF TIME
TO RESPOND TO NOTICE OF OPPOSITION

Applicant, on July 22, 2003, filed the motion set forth below but failed to include the opposition number on the motion. A copy of the July 22, 2002 motion is attached as Exhibit A and resubmitted, *instanter*. Applicant therefore requests that its unopposed motion for a fifteen (15) day extension of time to respond to the Notice of Opposition be granted.

Respectfully submitted,

GLOBAL DECOR

James B. Conte
Barnes & Thornburg
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 357-1313

Date: August 5, 2003

09/20/2003 11:49

PROOF OF SERVICE BY MAIL


Rose Ranegar, a non-attorney, certifies that on August 6, 2003, I served this **Resubmission of the Unopposed Motion for Extension of Time to Respond to Notice of Opposition** by mailing a copy, postage prepaid, on the parties identified below, and also via facsimile to the Commissioner of Trademarks:

Jeffrey H. Kaufman, Esq.
Amy C. Sullivan, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

BOX TTAB NO FEE
Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513
Fax (703) 305-3230

Under penalties as provided by the laws of the United States, I certify that the statements set forth herein are true and correct.

Date: August 6, 2003

Signature: 

Docket No. 926536-922812

BOX TTAB NO FEE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re the Application of:

GLOBAL DECOR

Filed: December 12, 2000

Mark: GLOBAL DECOR

Published in the Official Gazette
of March 19, 2002, Volume 1256,
No. 3, at Page TM 118

Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Commissioner:

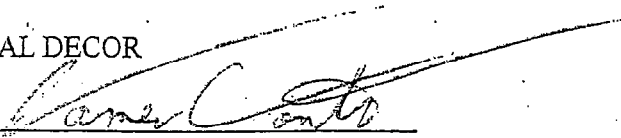
UNOPPOSED MOTION FOR EXTENSION OF TIME
TO RESPOND TO NOTICE OF OPPOSITION

Applicant's response to Yoshida Metal's Notice of Opposition falls due July 23, 2003. Opposer has consented to a fifteen (15) day extension for Applicant to file its response to Opposer's Notice of Opposition. Opposer gave Applicant consent on July 17, 2003. A copy of a letter facsimile to Opposer, confirming consent, is attached hereto.

Applicant requests that the Board grant Applicant's unopposed fifteen (15) day extension to file a response to Opposer's Notice of Opposition. The response would therefore be due on August 7, 2003.

Respectfully submitted,

GLOBAL DECOR


James B. Conte
Barnes & Thornburg
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 357-1313

Date: July 22, 2003

PROOF OF SERVICE BY MAIL

ROSE RANEGAR a non-attorney, certifies that on JULY 22, 2003

I served this **Unopposed Motion for Extension of Time to Respond to Notice of Opposition** by mailing a copy, postage prepaid, on the parties identified below:

Jeffrey H. Kaufman, Esq.
Amy C. Sullivan, Esq.
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

BOX TTAB NO FEE
Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Under penalties as provided by the laws of the United States, I certify that the statements set forth herein are true and correct.

Date: July 22, 2003
Signature: Rose Ranegar

BARNES THORNBURG

One Penn Plaza
New York, NY 10119
Tel: (212) 373-3000
Fax: (212) 373-3001

1111 1111-1111
1111 1111-1111
Email: to: [redacted]

July 18, 2003

VIA FACSIMILE (703) 413-2220 and U.S. MAIL

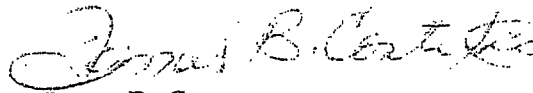
Amy C. Sullivan, Esq.
Oblon, Spivak, McClelland,
Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, Virginia 22314

RE: Yoshida Metal Industry Co., Ltd. v. Global Decor, Inc.
Our File No. 926536-922812

Dear Ms. Sullivan:

This letter will confirm our agreement that Global Decor will have an additional fifteen (15) days to respond to the Notice of Opposition and an additional thirty (30) days to respond to the outstanding discovery.

With kindest regards,


James B. Conte

JBC:rr

CASE NO. 926536-922812

Yoshida Metal Industry Co., Ltd.
v. Global Decor

Global Decor

Please acknowledge
receipt of the
enclosed:

OPPOSITION NO. 91/156,618

TRADEMARK: GLOBAL DECOR

FILING DATE: March 14, 2002

1. Applicant's Answer, Affirmative Defenses and Counterclaim in Response to Yoshida's Notice of Opposition (in triplicate)
2. Copy of Unopposed Motion for Extension of Time to Respond to Notice of Opposition
3. Certificate of Mailing
4. Return Post Card

DUE DATE (If Any):

DATE SENT: August 7, 2003

JBC/rr


08-11-2003
U.S. Patent & TMOc/TM Mail Rcpt Dt. #22

03 AUG 18 AM 9:22

I hereby certify that the correspondence is being Deposited with the United States Postal Service as first class mail in an envelope with sufficient postage addressed to:

Mail Stop - TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513
on the date indicated below:

Date: August 7, 2003

BY: 
Rose Ranegar